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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,232	07/24/2000	JOHN ROGER SAMPSON	SAMP-US1	2557

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

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DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/582,232

Applicant(s)

SAMPSON, JOHN ROGER

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-11 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11, 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action has been considered and the finality of the previous rejection is being withdrawn to include rejections of claims 27-30 under 35 USC 112 1<sup>st</sup> Paragraph.

#### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 9/20/02 is insufficient to overcome the rejection of claims 9-15 based upon insufficiency of disclosure under 35 USC 112 1<sup>st</sup> Paragraph as set forth in the last Office action because: The declaration fails to set forth evidence showing that when referring to permeability of a wrapper, absent an indication it is net permeability, it is assumed or customary to refer to inherent permeability. Applicant provides tables showing a list of papers denoting which papers have perforations but the evidence fails to show as alleged in the declaration "in the absence of any indication relating to additional perforations, the inherent or natural permeability It is customary to indicate that a wrapper has been perforated by electrostatic, mechanical or other means by expressly referring to such a procedure or by referring to the net permeability of a wrapper." A fair conclusion to draw from the facts presented in the tables is that when perforations are made to a wrapper and indications are made that permeability is measured when the paper is perforated then the other permeabilities referred therein denote inherent permeability. However, when Applicant's original disclosure does not denote or differentiate permeability from one another, an assumption that inherent permeability is intended cannot be asserted without further evidence to support this conclusion.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 1) Claim 9-11 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for a wrapper having an inherent permeability of at least 20 coresta units. The specification at the time of filing only discloses a permeability of 20 C.U but does not specify that the permeability is being defined as inherent permeability as claimed by applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2) Claims 9 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876). Hedge discloses a tobacco rod comprising a blend of shredded tobacco and reconstituted tobacco (Example 2). The reconstituted tobacco is treated with activated carbon having a particle size less than 150 microns and may comprise up to 50% by weight (Column

1, lines 20ff). The reconstituted tobacco may be in the form of a sheet (Column 1, lines 57-62). Hedge is silent disclosing the claimed porosity of the tobacco rod wrapper. However, as taught by Hayden et al wrappers typically have an inherent porosity below 400 C.U (Column 3, lines 53-64). Since Hedge is silent disclosing the claimed permeability it would have been obvious to a person of ordinary skill in the art to wrap Hedge's tobacco rod with ready available conventional cigarette wrappers known to have the claimed porosity.

**3)** Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876) as applied to claim 9 above and in further view of Raker et al (US 5261425). Hedge and Hayden are silent disclosing sources of carbon. However, the claimed sources of carbon are well known in the art as disclosed by Raker (Column 12, lines 40ff). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to use carbon particles with the cigarette resulting from the combination Hedge and Hayden's conventional wrapper with conventional sources of carbon particles as taught by Raker et al.

### ***Response to Arguments***

Applicant's arguments filed 9/20/02 have been fully considered but they are not persuasive. Applicant argues that there is no teaching or suggestion in Hedge that reconstituted tobacco sheets are equivalent or could be substituted for reconstituted tobacco in the form of filaments. Hedge's invention is directed to adding carbon particles

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in the claimed range as Applicant. Aside from providing carbon particles to reconstitute tobacco, another essential feature of Hedge's invention is to provide reconstituted tobacco free from adhesives (Column 1, lines 28-35). In order to provide tobacco free from adhesives, Hedge discloses reconstituted tobacco in either form, sheet or filament, may be applied with the claimed invention (Column 1, lines 64-65). Therefore, it is obvious to a person of ordinary skill in the art that tobacco in either form, sheet or filament, meets Hedge's essential requirement of adhesive free tobacco and furthermore it would be obvious to one of ordinary skill in the art that either form, filament or sheet, of reconstituted tobacco are equivalents of each other as implied by Hedge. In conclusion, it is held that either form of reconstituted tobacco are equivalents to one of ordinary skill in the art for the purpose of reducing aldehyde content of side-stream smoke.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the Raker and Hayden references individually, one cannot show nonobviousness by attacking references individually

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where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Raker reference is relied on to show that while Hedge is silent providing the source of carbon particle, applicant's claimed source is conventional source absent any specific carbon source, it would have been obvious to a person of ordinary skill in the art to have used conventional source as disclosed by Raker. As for the Hayden reference, absent any specific wrapper permeability a person of ordinary skill in the art would select conventional wrapper having the claimed permeability as shown by Hayden.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

C.L  
October 7, 2002